

REMARKS

I. Priority

In the Office Action, applicant's claim for domestic priority under 35 U.S.C. § 119(e) was acknowledged. However, the Office Action stated that the provisional application upon which priority is claimed (i.e., U.S. Provisional Patent Application No. 60/167,184) failed to provide adequate support under 35 U.S.C. § 112 for claims 1-32 of the above-identified application. The Office Action indicated that the provisional application does not include adequate support for the limitation of "comparing the targeting criterion to stored user information." Applicant respectfully disagrees.

Independent claims 1 and 17 are directed towards providing targeted messages to users of an interactive television application. A message having associated targeting criteria is created by a first processor at a first location (e.g., at the television distribution facility) and distributed to a user at a second location. "The message may be automatically discarded by any other user's message receipt/display application. That application may be an email application, may be part of a

program guide, or may be part of some other application. The application may be in the home (such as on a set-top box)" (Applicant's provisional application, page 3, lines 3-9). Stored user information may include, for example, a specific channel in a user's local lineup, a reminder that a user set for a specific program, a specific pay-per-view (PPV) program that a user ordered, a specific pay channel that a user is authorized to access, etc. (see, e.g., Applicant's provisional application, page 2, lines 3-9).

Applicant believes that claims 1-32 are in compliance with 35 U.S.C. § 112. Applicant respectfully requests that the Examiner's rejection be withdrawn.

## II. The Objections to the Drawings

The Examiner objected to the drawings as failing to comply with 37 C.F.R. § 1.84(p)(4) for including a reference character in the drawing that is used to designate both the keyboard and the monitor of FIG. 4. In response to this objection, applicant has amended FIG. 4 by changing the reference character used to designate the keyboard from reference character 62 to reference character 63. Applicant

has also amended the paragraph of the specification starting on page 13, line 26 to make a change that corresponds to the aforementioned change made to FIG. 4.

The Examiner also objected to the drawings as failing to comply with 37 C.F.R. § 1.84(p)(5) for including a reference character in the drawing that is not mentioned in the description. Specifically, the Examiner objected to the inclusion of reference character 60. In response to this objection, applicant has amended the paragraph starting on page 13, line 1 to include reference character 60 of FIG. 4.

Applicant respectfully submits that the drawings, as proposed, fully comply with 37 C.F.R. § 1.84(p)(4) and (5). Accordingly, the Examiner's objections to the drawings under 37 C.F.R. § 1.84(p)(4) and (5) should be withdrawn.

### III. Summary of Applicant's Claims

Independent claims 1 and 17, as amended, are directed towards providing targeted messages (e.g., an e-mail, a pop-up message, etc.) to users of an interactive television application. A message having associated targeting criteria is created at a first location by a first processor (e.g., a television service provider). The

message along with the targeting criteria are distributed from the first location to a user at a second location. The criteria associated with the message are compared to user information (e.g., user settings, channels or services subscribed to by the user, etc.) that is stored at the second location by a second processor (e.g., user equipment, a set-top box, a computer, etc.) in response to receiving the message from the first location. This does not occur in response to a request for such a message, neither from the second processor nor from the user. When the criteria are satisfied, the message may be presented to the user.

IV. The Ballard Rejection

The Examiner rejected claims 1-5, 15-21, 31, and 32 under 35 U.S.C. § 102(e) as being anticipated by Ballard U.S. Patent No. 6,128,050 (hereinafter "Ballard"). The Examiner's rejection is respectfully traversed.

Common to applicant's independent claims are applicant's features of distributing the message along with the targeting criteria from a first location to a second location, comparing the targeting criteria to user information stored at the second location in response to

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receiving the message from the first location and not in response to a request for the message, and presenting the message to the user when the targeting criteria are satisfied. Ballard, however, discloses a very different type of system. Ballard does not disclose distributing the message from the first location to the second location and comparing the targeting criteria to user information stored at the second location in response to receiving the message from the first location. Nor does Ballard disclose performing the comparison not in response to a request for the message. Instead, Ballard's end user computer determines which advertisements are to be displayed and then requests to receive the advertisement. These requested advertisements are subsequently relayed to the end user computer (See Ballard, column 12, lines 59-65). Ballard makes it clear that the advertising data sent to the end user computer includes target criteria but excludes the advertisement or message to be presented to the user (See Ballard, column 12, lines 41-45).

For the foregoing reasons, applicant respectfully submits that independent claims 1 and 17 are allowable over Ballard. Dependent claims 2-5, 15,

16, 18-21, 31 and 32 are dependent from claims 1 and 17 and are allowable over Alexander at least because claims 1 and 17 are. Accordingly, applicant respectfully requests that the rejection of claims 1-5, 15-21, 31 and 32 be withdrawn.

V. The Alexander Rejections

The Examiner rejected claims 1-7, 11, 14-23, 27, and 30-32 under 35 U.S.C. § 102(e) as being anticipated by Alexander et al. U.S. Patent No. 6,177,931 (hereinafter "Alexander").\* The Examiner also rejected claims 10 and 26 under 35 U.S.C. § 103(a) as being unpatentable over Alexander. The Examiner also rejected claims 8, 9, 12, 13, 24, 25, 28 and 29 under 35 U.S.C. § 103(a) as being unpatentable over Alexander in view of Knee et al. U.S. Patent No. 5,589,892 (hereinafter "Knee"). The Examiner's rejections are respectfully traversed.

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\* Applicant notes that although the Examiner does not list claims 6, 7, 11, 14, 22, 23, 27, and 30 in the heading of the rejection, the Examiner provides reasoning for their rejection in the following comments. Accordingly, applicant will treat claims 6, 7, 11, 14, 22, 23, 27, and 30 as being rejected by the Examiner under 35 U.S.C. § 102(e) as being anticipated by Alexander.

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The Examiner contends that Alexander discloses all the features of independent claims 1 and 17. Alexander refers to an electronic program guide (EPG) that provides, among other things, improved opportunities for commercial advertisers to reach viewers. More specifically, Alexander discloses an electronic program guide that collects and updates information about a viewer's viewing habits into a "Viewer's Profile". Based on the information stored in the Viewer's Profile, various aspects of the electronic program guide, such as presentation of advertising, may be customized (See, e.g., Alexander, column 28, lines 30-52 and column 32, lines 23-34).

While applicant's invention may implicate the teachings of Alexander, applicant patentably improves upon Alexander by comparing targeting criteria to user information in response to receiving the message and not in response to a request for the message, as specified in independent claims 1 and 17.

The Examiner relies on Alexander to show that the reference discloses creating an advertisement having associated targeting criteria, distributing it to users, and presenting it when the criteria satisfies stored user

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information associated with the Viewer Profile. However, Alexander also demonstrates that the electronic program guide requests such advertisements either by selecting them from a library of advertisements, selecting them according to pre-established criteria, accessing them locally or through the Internet, etc. In contrast, the messages as defined in applicant's independent claims are distributed to users along with their associated targeting criteria, which are compared to user information not in response to a request for such a message.

For the foregoing reasons, applicant respectfully submits that independent claims 1 and 17 are allowable over Alexander. Dependent claims 2-16 and 18-32 are dependent from claims 1 and 17 and are allowable over Alexander at least because claims 1 and 17 are. Accordingly, applicant respectfully requests that the rejections of claims 1-32 be withdrawn.

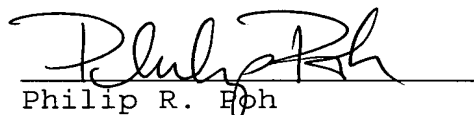


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VI. Conclusion

For the reasons set forth above, this application is in condition for allowance. Entry of the amendments and a favorable action are respectfully requested.

Respectfully submitted,



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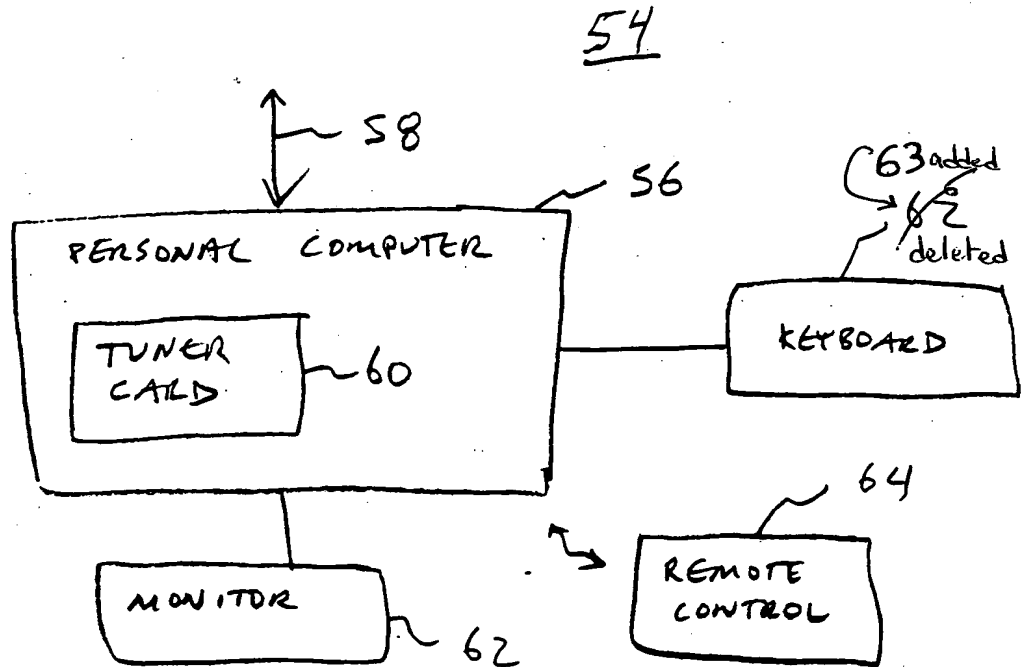


FIG. 4